

REMARKS

This Amendment is submitted in response to the Office Action mailed on February 7, 2007. Applicants' counsel appreciates the courtesy extended by Examiner Dunwoody during the telephone interview conducted on June 7, 2007. Claim 1 has been amended as discussed during the telephone interview, and claims 1-5 remain pending in the present application. In view of the foregoing amendments, as well as the following remarks, Applicants respectfully submit that this application is in complete condition for allowance and request reconsideration of the application in this regard.

Claims 1-5 stand rejected under 35 U.S.C. §112, second paragraph, for allegedly being indefinite. While Applicants respectfully traverse this rejection, Applicants have amended independent claim 1 to clearly overcome the rejection and respectfully request that the rejection be withdrawn.

In particular, Examiner takes the position that it is unclear whether Applicants intend to claim the sub-combination of a mounting fixture for connecting pipettes of various sizes to the air chamber of a pipettor or the combination of a mounting fixture and pipette. As Examiner will note, independent claim 1 recites that the stabilizing member is "configured" to radially confine and support pipettes received in the axial passageway of the retainer so that the pipettes are not being positively claimed. Applicants have further amended independent claim 1 to recite that the stabilizing member is further "configured" so that the pipettes extend through a distal

end of the stabilizing member. This amendment is made to clarify that the pipettes are not being positively claimed.

Claims 1-5 also stand rejected under 35 U.S.C. §103(a) as being unpatentable over Pepicelli et al., U.S. Patent No. 4,257,268 in view of Smith, U.S. Patent No. 6,117,394. Applicants respectfully traverse these rejections for the reasons set forth below and respectfully request that the rejection be withdrawn.

As Examiner properly recognizes, Pepicelli et al. is completely silent with respect to a stabilizing member at the open distal end of the nose. During the telephone interview, Examiner expressed his position that the pipettor of Pepicelli et al. could be modified to include the disposable tip (Tp) of Smith, with the pipettor of Pepicelli et al. further modified to include a pipette received within the pipette tip (Tp) of Smith so that the pipette tip (Tp) of Smith stabilizes the inserted pipette as claimed by Applicants. Applicants respectfully traverse Examiner's position.

At the outset, Examiner's hypothetical combination of Pepicelli et al. with Smith would fail to achieve Applicants' claimed invention as recited in independent claim 1 since the pipette tip of Smith includes a membrane filter (M) positioned within the filter tip (Tp). Applicants respectfully submit that the membrane filter (M) would prevent a pipette from being inserted into the distal end of the Smith pipette tip (Tp) and engaged with the adaptor (14) of Pepicelli et al. For this reason, the rejections must fail.

Moreover, Applicants respectfully submit that the proposed reconstruction and redesign of the Pepicelli et al. pipettor by the inclusion of the pipette tip (Tp) of Smith is motivated solely by Applicants' own disclosure. It is well settled that the mere fact that the prior art may be modified in the manner suggested by Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. See *In re Fritch*, 23 USPQ 2d 1780, 1783-84 (Fed. Cir. 1992). It is improper to use Applicants' own disclosure as a "teaching tool" to teach the manner in which the prior art may be redesigned or reconstructed so that the claimed invention is rendered obvious. *Id.* The necessity of avoiding hindsight reconstruction was well stated by the Court of Customs and Patent Appeals in the case of *In re Rothermel and Waddell*, 125 USPQ 323, 331 (CCPA 1960), wherein the court noted:

The Examiner and the Board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in light of appellants' disclosure... It is easy now to attribute to this prior art the knowledge that was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill of the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of claims, it is not the type of rejection which the statute authorizes. 35 U.S.C. 103 is very specific in requiring that a rejection on the grounds the invention would have been obvious must be based on a comparison between the prior art and the subject matter as a whole at the time the invention was made.

In this instance, Examiner has failed to establish a *prima facie* case that one of ordinary skill in the art would be motivated to modify the pipettor of Pepicelli et al. to include the pipette tip (Tp) of Smith, and further would be motivated to insert a pipette within the pipette tip (Tp) of Smith so that the pipette tip (Tp) of Smith is configured to radially confine and support pipettes received in the axial passageway of the pipettor with the pipettes extending through a distal end of the pipette tip (Tp) as claimed by Applicants in independent claim 1. Rather, Applicants respectfully submit that such reconstruction and redesign is only obtained through improper hindsight using Applicants' own disclosure as a template in an attempt to render the claimed invention obvious. For this reason as well, Applicants respectfully submit that the Examiner's rejections must fail.

For the above reasons, Applicants respectfully submit that each of independent claim 1, and claims depending therefrom, recites a combination of elements not taught or suggested by the prior art of record and the rejections should be withdrawn.

Conclusion

In view of the foregoing response including the amendments and remarks, this application is submitted to be in complete condition for allowance and early notice to this affect is earnestly solicited. If there is any issue that remains which may be

Application No. 10/784,385
Amendment Dated 6/7/07
Reply to Office Action of 2/7/07

resolved by telephone conference, the Examiner is invited to contact the undersigned in order to resolve the same and expedite the allowance of this application.

In accordance with 37 C.F.R. §1.17(a)(1), Applicants have submitted herewith electronically the \$120.00 fee for the one (1) month extension. If any additional fees are necessary to complete this communication, the Commissioner is hereby authorized to charge any underpayment or fees associated with this communication or credit any overpayment to Deposit Account No. 23-3000.

Respectfully submitted,

WOOD, HERRON & EVANS, L.L.P.

/David H. Brinkman/
David H. Brinkman, Reg. No. 40,532

2700 Carew Tower
441 Vine Street
Cincinnati, Ohio 45202
(513) 241-2324 - Voice
(513) 421-7269 - Facsimile